REMARKS

Claims 4, 8, and 13-23 are pending in the present application. Reconsideration of the claims is respectfully requested, based on the arguments presented below.

I. 35 U.S.C. § 103, Obviousness: Claims 4, 8, and 13-23

Claims 4, 8, and 13-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Markus** *et al.*, Server for Enabling the Automatic Insertion of Data into Electronic Forms on a User Computer, U.S. Patent no. 6,490,601, December 3, 2002 (hereinafter "**Markus**") in view of **Dipaolo** *et al.*, Electronic Data Entry System Employing an Expert System to Facilitate Generation of Electronic Data Forms with Complex Interrelationships Between Fields and Subforms, U.S. Patent No. 5,367,619, November 22, 1994 (hereinafter "**Dipaolo**"). This rejection is respectfully traversed.

The rejection states:

> 4. Referencing claim 4, as closely interpreted y the Examiner, Markus teaches an information processing method in an information processing system having an information terminal support server which supports an information terminal connected to a content server and loaded with a client program, the method comprising the steps of:
>
> 5. (a) receiving, at the information terminal support server, a message snt from the content server responding to a request from the information terminal, wherein the message includes content, (e.g., col. 16, lines 8-28);
>
> 6. (b) determining whether or not said message agrees with a predetermined condition, (e.g., col. 5, lines 13-44 & col. 9, lines 19-34)
>
> 7. (c) editing said message to insert a command in association with the content for the client program if said message agrees wth said predetermined condition, wherein the command is executable at the information terminal of the client program with respect to the content, (e.g., col. 15, line 41 – col. 16, line 28); and
>
> 8. (d) sending said message in edited form to the information terminal, (e.g., col. 15, line 41-col. 16, line 28), but does not specifically teach prohibiting a behavior. Dipaolo teaches prohibiting a behavior, (e.g. col. 11, lines 31-69). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Dipaolo with Markus because if a field in a form is marked for protection then t would be used to stop users from mistakenly changing values in fields that could cause errors in the system and also protect a field that is automatically set such as a automatic menu field.

Office Action dated November 3, 2005, pages 2-3

The determination of "nonobviousness" is made after establishing the scope and content of prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art. *Graham v. John Deere*, 383 U.S. 1 (1966). In addition, all limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994).

Exemplary claim 4 recites:

> 4. (Previously presented): An information processing method in an information processing system having an information terminal support server which supports an information terminal connected to a content server and loaded with a client program, the method comprising the steps of:
> (a) receiving, at the information terminal support server, a message sent from the content server responding to a request from the information terminal, wherein the message includes content;
> (b) determining whether or not said message agrees with a predetermined condition;
> (c) editing said message to insert a command in association with the content for the client program if said message agrees with said predetermined condition, wherein the command is executable at the information terminal to prohibit a behavior of the client program with respect to the content; and
> (d) sending said message in edited form to the information terminal.

Exemplary claim 4 is not obvious over the combination of **Markus** with **Dipaolo** because neither of these patents, either alone or in combination, meet all of the features recited in claim 4. In understanding how the combination of **Markus** and **Dipaolo** falls short of meeting the features recited in claim 4, it is helpful to look first at the interactions recited in the claimed invention and how these compare to interactions in the references relied on. A quick overview of the interactions disclosed by the application and by **Markus** will be shown, followed by a discussion of the shortcomings of specific claim features.

It is noted that most of the steps recited in exemplary claim 4 are logically performed in the order in which the steps are recited. More specifically, since the editing step is dependent on the determination made in the determining step, the determining step precedes the editing step; the sending step occurs after the editing step since the message is sent in edited form. Further, since the edited message is sent to the information terminal or user terminal, the recited steps would occur outside of the information terminal; it is specifically recited that the receiving step occurs at the information terminal support server. Thus, the activities recited in exemplary claim 4 take place somewhere between the content server that sends the message and the information

terminal that receives the message in edited form. Such a relationship is illustrated in Figure 2 of the current application, reproduced below, where the support server interacts with both the information terminals 132 and the content server (or web server) 140. Because the support server passes messages between the content server 140 and the information terminal 132, the support server is able to manipulate information passed between these two computers and modify messages before they are delivered.

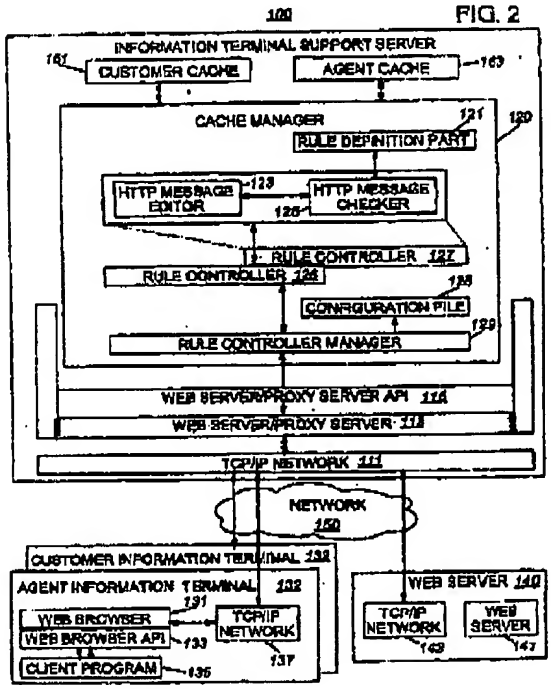


FIG. 2

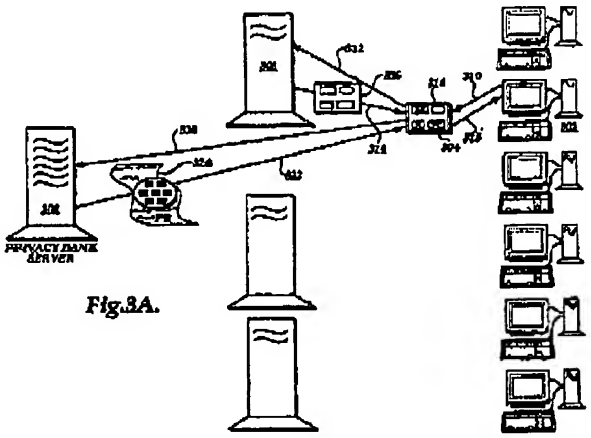


Fig.3A.

Markus ↑

← Current application

According to the rejection, **Markus** is relied on to show the steps recited in claim 4, with the exception of the inserted command prohibiting a behavior. The system used in **Markus** is shown in Figure 3A of that patent, reproduced above. **Markus** describes this figure thus:

> FIG. 3A is a block diagram of a system for automatically filling out electronic form documents in accordance with one embodiment of the present invention. ... In the described embodiment an end-user computer 302 is a stand-alone computer with access to the Internet and contains an Internet browser program, a browser window for which is shown at 304. In the center of the diagram is a number of Web servers. A particular Web server 306 is a server for a merchant Web site, such as www.fishermanstore.com to which users or consumers can visit to purchase goods online over the Internet. On the left side of the diagram is a specialized electronic resource referred to in the described embodiment as a privacy bank server computer 308, also connected to the Internet.

> The process of automatic electronic form completion begins with a user downloading the form from a Web site such as fishermanstore site. ... a user consumer on computer 302 ("user 302") opens a browser window 304 in an Internet browser program such as Netscape Navigator or Internet Explorer, depicted by arrow 310. User 302 then goes to www.fishermanstore.com shown by arrow 312 via the browser and decides to purchase goods. User 302 then downloads from the Web site contained on Web server 306 an electronic purchasing form that needs to be completed as depicted by arrow 314. A purchasing form 316, typically an HTML document, is returned and downloaded into and displayed in browser window 304. At this juncture, user 302 would normally have to "manually" fill in each field in purchasing form 316. Much of this information is typically standard: name, address, phone number, payment method, user email address, etc. In accordance with one embodiment of the present invention, user 302 can "click" on a privacy bank icon or button in form 316 and have the form automatically filled in.
>
> As stated earlier, it is assumed in this discussion that www.fishermanstore.com is registered with and thus an affiliate member of the privacy bank service assessable from privacy bank server 308. Being an affiliate member of the privacy bank service, purchasing form 316 contains a privacy bank icon or button 318. By clicking on privacy bank icon 318, user 302 essentially completes a process for automatically filling in form 316 by transparently transmitting a completed form to the privacy bank service on server 308, depicted by an arrow 320. The information needed for filling in the form is transmitted to user 302 once form 316 (an HTML document) is parsed, which occurs when form 316 is downloaded. This process is described in greater detail in FIGS. 4A and 4B. User 302 informs privacy bank server 308 of the identity of the user and of which Web site and which form on that Web site (if more than one) the user wishes to have filled in. This information is transmitted to privacy bank server 308, unbeknownst to user 302, when form 316 is downloaded. Techniques for accomplishing this are described below. Once privacy bank server 308 receives a request from registered user 302 (by virtue of an external link in form 316 executed when the form is parsed by user 302), it begins preparing information needed to fill in form 316 on user computer 302. A process of preparing the information sent back to user computer 302 and browser 304, depicted by arrow 322, is described in greater detail in FIGS. 6 and 7.

Markus, column 7, line 24 through column 8, line 22

It is clear from Figure 3A of **Markus** and the discussion of that figure that the user's browser is in direct communication with both the merchant's Web server 306 and the privacy bank server 308. The rejection appears to read the claimed content server on the merchant's Web server 306 of **Markus**, the claimed information terminal support server on the privacy bank server 308 of **Markus**, and the claimed information terminal on the user computer 302 of

Markus. However, there is nothing in **Markus** that could logically intercede between Web server 306 that sends content and the user computer 302 that receives the content. Instead, **Markus** shows a purchasing form 316 sent from Web server 306 directly to the browser 304 on user computer 302. **Markus** also shows the privacy bank server 308 sending JavaScript program 324 directly to user computer 302. While the JavaScript program 324 contains instructions, these instructions are not inserted into the requested content prior to the transmission of the content to computer 302. Indeed, there is no mechanism by which these instructions could be inserted into the requested content prior to its transmission to computer 302.

Turning now to the steps recited in exemplary claim 4, the claim features are shown in bold below, while the shortcomings of the references relied are given immediately afterwards:

- "***receiving, at the information terminal support server, a message sent from the content server***" – Privacy bank server 308 does not receive a message sent from Web server 306 to user computer 302. Instead, both privacy bank server 308 and Web server 306 communicate directly with the browser on user computer 302.
- "***editing said message to insert a command in association with the content for the client program if said message agrees with said predetermined condition***" – The privacy bank server 308 sends JavaScript program 324, but the program is not inserted into the content of the message, as the privacy bank server 308 does not receive a message before it goes to the user computer 302.
- "***sending said message in edited form to the information terminal***" – No edited message is created, since the privacy bank server 308 does not intercept the message.
- "***wherein the command is executable at the information terminal to prohibit a behavior of the client program with respect to the content***" – **DiPaolo** has been cited as disclosing this feature. While it is true that **DiPaolo** discloses that a "*protect attribute ... is used to indicate that a field is protected*" (column 11, lines 48-49), the most obvious manner of combining this aspect of **DiPaolo** with **Markus** would be to provide a protection attribute on the form created by a merchant. This combination, however, would not meet the feature recited in claim 4. **Markus** does not show that a command is executable to prohibit a behavior. Therefore, the feature is also not met by the references relied upon.

Thus, Applicants have shown numerous features of claim 4 that are neither shown nor suggested by **Markus** or by **DiPaolo**. Therefore, the rejection of claim 4 is overcome.

Additionally, claims 8 and 13 are rejected for the same reasons as claim 4, so their rejections are also overcome. Claims 14-23 each depend from one of claims 4, 8, or 13, so the rejection of these claims is also overcome.

Therefore, the rejection of claims 4, 8, and 13-23 under 35 U.S.C. § 103(a) has been overcome.

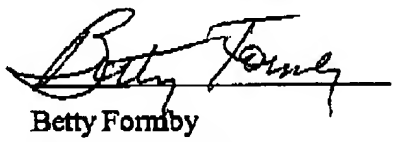
II. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: January 3, 2006

Respectfully submitted,



Betty Formby
Reg. No. 36,536
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Agent for Applicants